

Application No.: 09/989,414
Art Unit 2627

Attorney Docket No. 3449-0179P
Reply to March 19, 2008 Office Action
Page 5 of 9

REMARKS

Applicant thanks the Examiner for the thorough consideration given the present application.

Claims 1-3, 5-9 and 11 are pending in the present application. By this Amendment, claims 1-3, 5 and 13 are amended. No new matter is involved.

Reconsideration of the Application, as amended, is respectfully requested in light of the aforementioned Amendment and the following remarks.

Objection

Claim 11 is objected to because of an antecedent basis issue. This objection is respectfully traversed because claim 11, as amended, complies with the grammatical rules of antecedent basis.

Reconsideration and withdrawal of this objection to claim 11 are respectfully requested.

Rejection under 35 USC §112, Second Paragraph

Claims 1-3 and 5-9 stand rejected under 35 USC §103(a) as being indefinite. This rejection is respectfully traversed.

The Office Action indicates that it is unclear (1) how the step "detecting a track of a focus error at the maximum value of an RF signal or at the minimum of jitter," as recited in claim 1, is interrelated with the rest of the steps in the claim; (2) how the step calculating a variation per track of the maximum value and the minimum value of the focus error to detect a normalized DC component, as recited in claim 2, is interrelated with the steps recited in claim 1; and (3) whether the language "the variation per track" in claim 3, refers to the "variation per track of the focus error"

JTE/RJW/jmc

Application No.: 09/989,414
Art Unit 2627

Attorney Docket No. 3449-0179P
Reply to March 19, 2008 Office Action
Page 6 of 9

of claim 1, or the "variation per track of the maximum value and the minimum value of the focus error" of claim 2.

The test for compliance with the second paragraph of 35 U.S.C. §112, as stated in *Miles Lab., Inc. v. Shandon Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), *cert. denied*, 510 U.S. 1100 (1994) is whether one skilled in the art would understand the bounds of the claims when read in light of the specification. If the claims, read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more. *See, also, In re Merat*, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975), which stated that the question under Section 112, second paragraph is whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct. *See, also, In re Warmerdam*, 33 F3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

The second paragraph of 35 U.S.C. §112 requires claims to be set out and circumscribe a particular area with a reasonable degree of precision and particularity, *In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

Applicants respectfully submit that the claims fully comply with 35 U.S.C. §112, second paragraph as they stand and because one of ordinary skill in the art can readily determine the metes and bounds of the invention keeping in mind that the term "track" conventionally has a more than one definition, and that term, as used in this Application and in these claims, similarly has different definitions.

JTE/RJW/jmc

Application No.: 09/989,414
Art Unit 2627

Attorney Docket No. 3449-0179P
Reply to March 19, 2008 Office Action
Page 7 of 9

Evidence of the fact that the term "track" in this Application has more than one definition is found, for example, on page 1 of this Application, which states that the optical disk has signal tracks constituted by lands and grooves so that tracking can be controlled; and on page 3, which states that when the light beam crosses over the adjacent track, it will be judged that the tracking servo incorrectly traces the track even if the focus of the object lens is at the center of the tracks.

The aforementioned page 1 disclosure of "track" is in the context of a physical track made up of lands and grooves, whereas the page 3 disclosure of "tracking" is in the context of "tracing" of the physical track.

With this in mind, Applicant respectfully submits that the recitation of "detecting a track of a focus error" of line 2 of claim 1 is based on a definition of "track" as "trace," whereas the recitation of "calculating a variation per track" in line 5 of claim 1 is based on a definition of "track" as "physical track." Applicant also notes that conventional thesauri indicate that "trace" is a known synonym for "track."

Because of this, and because the word "trace" is found in Applicant's disclosure as originally filed, Applicant has amended the first occurrence of "track" in claim 1 to read - - trace - -. Additionally, Applicant has amended the second occurrence of "track" in claim 1 to read - - physical track - -.

Similar, appropriate amendments have been made to claims 2, 3, 5 and 7.

With these amendments, Applicants respectfully submit that the claims quite clearly make sense to one of ordinary skill in the art and, because of this, the metes and bounds of the claimed

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Application No.: 09/989,414
Art Unit 2627

JUL 21 2008

Attorney Docket No. 3449-0179P
Reply to March 19, 2008 Office Action
Page 8 of 9

invention are clear to one of ordinary skill in the art, as required by 35 USC §112, second paragraph.

Accordingly, reconsideration and withdrawal of this rejection of claims 1-3 and 5-9 are respectfully requested.

Conclusion

Applicant respectfully submits that the aforementioned amendments to claims 1-3, 5 and 13 place this Application in condition for allowance.

Under the circumstances, Applicant respectfully requests that this Application be promptly passed to issue.

Applicants respectfully petition under the provisions of 37 C.F.R. § 1.136(a) and § 1.17 for a one-month(s) extension of time in which to respond to the Examiner's Office Action. The Extension of Time Fee in the amount of \$120.00 is attached hereto.

JTE/RJW/jmc

Application No.: 09/989,414
Art Unit 2627

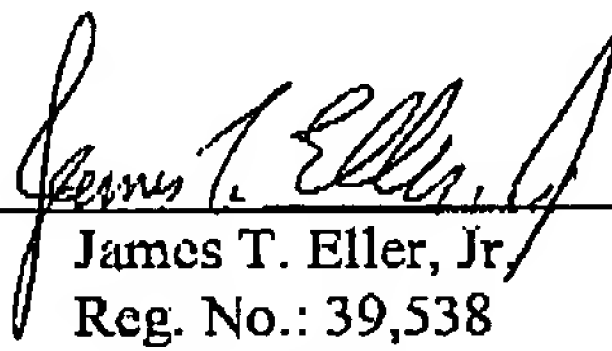
Attorney Docket No. 3449-0179P
Reply to March 19, 2008 Office Action
Page 9 of 9

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: July 21, 2008

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 
James T. Eller, Jr.
Reg. No.: 39,538
P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703) 205-8000
Attorney for Applicant

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